

## REMARKS

Claims 1-13 and 21-32 are currently pending in the application. Claims have been amended.

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### 35 U.S.C. §§ 102(b) and 103(a)

In the November 29, 2005 Office Action, the Examiner rejected of claims 1-13 and 21-32 under 35 U.S.C. § 102(b) as being anticipated by a document “The Official Software Companion Microsoft Profit” (“Profit 1”). The Applicants respectfully thank the Examiner for attaching the relevant portion of the prior art. Moreover, the Applicants respectfully traverse the rejection. Further, the Applicants believe the Examiner misstated the rejection and the rejection under 102(b) should have been for claims 1, 3-11, 13, 21-23, 25-29, and 32 rather than claims 1-13 and 21-32. The Examiner further rejected claims 2, 12, and 24 under 35 U.S.C. § 103(a) as being unpatentable and obvious in view Profit 1 in view of a section from “Computer Security Basics. The Applicants respectfully traverse the rejections. The Examiner also rejected claims 30 and 31 under 35 U.S.C. § 103(a) as being unpatentable and obvious over Profit in view of Profit 1 in further view of United States Patent 5,257,377 (“Sathi et al.”) The Applicants respectfully traverse the rejections.

Regarding the Examiner’s remarks to Applicants arguments, it is respectfully submitted the majority are moot in view of the above and below remarks.

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The applicants wish to address the 35 U.S.C. §§ 102(b) and 103(a) first below because it appears the Examiner may misunderstands the present invention. In particular, the Examiner relies on a disclosure that relates to a software package, more particularly an accounting software package. To assist in the installation of the software package, the software package is provided with an installation wizard. Applicants do not dispute that the Profit software as detailed more below in fact has an installation wizard. However, the present invention relates to a method and device for “the development of implementation installation software.” Conversely, and at most,

the Profit software and its associated manuals at most have installation software. They do not disclose, suggest, teach, or even describe “the development of the implementation installation software,” but rather only disclose using such implementation installation software provided. The applicants submit that the references have nothing to do with the development of the installation software, but rather the use. Moreover, many different programming techniques may have been used to develop the installation software, and the applicants respectfully submit that the Examiner is using improper hindsight in view of the present invention to assume the installation software provided must have been developed using the present invention.

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Looking specifically to amended claim 1, it relates to and recites a combination of elements including, for example, a “method in a computer system for enabling the development of implementation installation software by an expert for use by an end user to solicit and implement business related data for a software package comprising at least one independent module, the method comprising the steps of: generating at least one question definition screen; entering by the expert at least one question on the at least one generated question definition screen, the at least one question entered by the expert being designed to solicit at least first information from an end user relating to a business of the end user; determining whether additional information relating to the business of the end user is necessary to implement the software package on a computer system of the end user, the software package comprising executable instructions to perform a plurality of tasks wherein at least one of the tasks requires the additional information; if additional information is necessary, providing links to next questions to solicit additional information; if additional information is not necessary, compiling the at least one entered question into implementation installation software designed to solicit information from the end user relating to the business of the end user such that the solicited information from the end user is used to set specific options in the at least one independent module of the software package requiring the solicited information so the at least one independent module of the software package can be implemented and installed on the computer system of the end user; and wherein later addition of independent modules uses the solicited

information from the end user to ensure the later addition independent modules are implemented consistent with the software package and at least the first information relating to the business of the end user," which is not disclosed or suggest by Profit. Rather, Profit discloses a software package that happens to have an installation wizard, but provides zero teaching regarding how that installation wizard was developed.

The applicants readily admit that the Profit software package has an installation wizard and that the installation wizard both loads and implements the profit program, including interaction between databases, but the present invention as recited by the claims is not directed to a software package with an installation wizard but rather the present invention relates (to paraphrase) to the development of the installation wizard for the software package in the first instance. In fact, the difference between prior art and the present invention is clear by looking at the title of Profit 1. The title of Profit 1 is "Installing Microsoft Profit." In other words, the Profit 1 document steps you through installing profit using many windows and dialog boxes that are displayed to gather information from the end user. Profit 1 has no disclosure about development of the installation software, but rather simply uses software already develop, and it is silent regarding the development of the installation software. To the extent the Examiner believes the installation software associated with Profit was developed by generating at least one question definition screen; entering by the expert at least one question on the at least one generated question definition screen, the at least one question entered by the expert being designed to solicit at least first information from an end user relating to a business of the end user; determining whether additional information relating to the business of the end user is necessary to implement the software package on a computer system of the end user, the software package comprising executable instructions to perform a plurality of tasks wherein at least one of the tasks requires the additional information; if additional information is necessary, providing links to next questions to solicit additional information; if additional information is not necessary, compiling the at least one entered question into implementation installation software designed to solicit information from the end user relating to the business of the end user such that the solicited information from the end user is used to set specific options in the at least one independent module of the software package requiring the solicited information so the at least

one independent module of the software package can be implemented and installed on the computer system of the end user; and wherein later addition of independent modules uses the solicited information from the end user to ensure the later addition independent modules are implemented consistent with the software package and at least the first information relating to the business of the end user” is pure conjecture and using the teachings of the present invention to suppose that the programmers for profit must have developed the installation software in the same manner. In fact, the applicants are at a loss to find one reference in Profit 1 making any mention of how the installation software, including the screens and dialog, were developed. However, the mere fact that the installation programs work in a similar manner once develop is insufficient to support a finding of anticipation as Profit 1 does not enable the present invention. The only possible way the Examiner can reach the present conclusion is to use the teachings of the present invention and conclude the installation program for the Profit must have been developed using the present invention. However, this is improper use of hindsight.

For example, Profit 1 at page 26 shows a window displayed during the installation of Profit. The window display happens to have a question and solicits information from an end user. However, the fact that a window exists does not disclose how the screen, question, and dialog box in installation program was generated. The present invention relates to a method to generate the window displayed on page 26 and not the fact that the window exists. The fact that the window exists does not enable one of skill in the art to make or use the present invention because that window may have been created using a number of different programming techniques, some of which are disclosed in the background of the invention. As mentioned above, the Examiner is using impermissible hindsight to conclude that because the window in the installation software exists, it must have been developed using the present invention. However, that is simply not true.

The remaining references to Profit 1 identified by the Examiner show no more than additional window displays from the installation software for profit. The additional examples have no disclosure, suggestion, teaching, or information regarding how those windows were generated. As is clear, claim 1 relates to “the development of implementation installation software,” and not to the use of that software once developed, to which Profit 1 is directed.

Computer Security Basics and Sathi et al. do not relate to, disclose, suggest, or teach the development of installation software. Thus, they do not cure the defect noted above.

For at least this reason, claim 1 is not anticipated by Profit 1. Amended independent claims 7, 11, 21, 29, and 32 contains limitations similar to amended claim 1 and at least by virtue of the similarity, are not anticipated by Profit 1. Claims 2-6 and 8-10, 11-13, 22-28, 30, and 31 depend either directly or indirectly from claims 1, 7 11, 21, 29, and 32 and, at least by virtue of the dependency, are not anticipated by Profit 1. Moreover, because Computer Security Basics and Sathi et al. are silent regarding the development of installation software, thus, claims 1-13 and 21-32 are not anticipated or obvious in view of the references either alone or in any reasonable combination thereof. Thus, withdrawal of the rejection of pending claims and allowance of the claims is respectfully requested.

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In the November 29, 2005 Office Action the Examiner seems to misunderstand the present invention and based on the misunderstanding applies the references to reject the claims of the present invention. The Applicants believe the Examiner's apparent confusion would be clarified by a simple telephone conference or demonstration of the present invention, but the Examiner has denied requests for discussion. In any event, as explained in detail above, the Applicants completely, and clearly, traverse the rejections under 35 U.S.C. §§ 102(b) and 103(a). To the extent the Examiner is determined not to allow this clearly novel and unobvious patent application to proceed to issuance, the Applicants request the speedy issuance of a final rejection in this matter to move this long overdue case to appeal.

35 U.S.C. § 112, first paragraph

The Examiner rejected claims 1-13 and 21-32 under 35 U.S.C. § 112, first paragraph, as being non-enabling. The applicants respectfully traverse the rejection. As an initial matter, the Examiner has stated: "‘First User’ critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure." It is unclear to applicants how a term,

first introduced in an amendment on April 21, 2005 to clarify the distinctions between multiple end users could in anyway be critical or essential to the invention disclosed in the original specification. Moreover, there is not such a requirement or test for the essence of an invention, as the Examiner seems to suggest. Thus, the rejection is not understood fully. Moreover, the Examiner is respectfully direct to MPEP section 2164.08 establishing that the feature must be taught in the specification as critical and further not merely preferred. In this case, the term first user is not highlighted as particularly important in the specification. However, instead of arguing the position, the applicants have amended the recitation back to the term "end user" provided in the original claims of the application.

The Examiner also stated the phrase "End User" to be more than one role. The applicants request the Examiner clarify this statement as the Examiner's position is not understood. The "End User" is the user that installs (i.e., loads and implements) the complex software package. To the extent the Examiner believe End User means something else, the Applicants would request for some clarity on what the rejection means and if the Examiner has a suggestion regarding more appropriate language, the applicants would appreciate such suggested language.

The Examiner also stated the terms "expert" user and "non expert" user are not mutually exclusive. The Applicants are perplexed by this statement as the terms are in fact mutually exclusive. However, the phrase non-expert has been removed from the claims to expedite the present case. Moreover, it is respectfully submitted that the term expert is sufficiently clear. For example, one of ordinary skill in the art needing an expert in Hyperion enterprise software would certainly know how to contact such as expert. Moreover, complex accounting software programs, such as, the Great Plains Solomon Select/Premier has identifiable experts. Moreover, the present invention specifically states to install complex software, an end user employs a "specially trained software installation expert." Thus, it is respectfully submitted that the term expert is sufficiently quantifiable as it is clearly understood by one of ordinary skill in the art. Regarding the user of the phrase "intermediate expert user," the term intermediate was simply a term to signify prior to the end user. The term is unnecessary and has been eliminated from the claim.

Regarding the phrase “complex software packages” not having support, the applicants respectfully disagree. The originally specification clearly establishes the type of software package pertinent to the present invention. In one example in the specification, complex software packages are those for which specially trained software installations experts are employed. Moreover, the background of the invention clearly establishes the type of software package at issue in the present invention as complex software packages as those having multiple interrelated operating modules, such as, for example, complex accounting software packages. Moreover, the detailed description the software as having database interactions and pathways (see, for example, page 6, lines 31-3 and other text). Thus, one of ordinary skill in the art would clearly understand the phrase “complex software package” based on reading the specification as a whole, but if the Examiner prefers, the applicants would be happy to remove the designator complex phrase.

Regarding the Examiner’s position that terms are subject to speculation as a basis to reject the claims is misguided. The terms need to be sufficient to explain to one of ordinary skill in the art the scope of the invention. The applicants respectfully submit that the terms provided meet such a requirement. Furthermore, evidence that terms subject to speculation are clear in many patents issued from the patent office. Terms such as, fore example, about, approximate, similarly, substantially, etc. are clearly subject to speculation, but regularly allowed. In this regard, the Examiner is respectfully directed to MPEP section 2173 identifying that the terms must define the subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of the terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encourage to suggest claim language to applicants to improve the clarity of precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by the applicants satisfy the statutory requirement.” (emphasis in original) To determine whether the terms are reasonably particular, the Examiner should look to the content of the application, the prior art, and the interpretation one of ordinary skill in the art would provide. In fact, the Courts only require the terms to be as accurate as the subject matter permits. Thus, based on the above, it is clear to applicants that the claim terminology is

sufficient, but the applicants would be willing to listen to suggestions from the Examiner should the Examiner continue to maintain this rejection. Further, as the MPEP requires, the applicants urge the Examiner to suggest language the Examiner deems more appropriate for consideration should the Examiner maintain the present position.

The Examiner further rejected the term implement, implementation, implementing, etc. As explained previously without objection by the Examiner in paper filed September 2004, one of ordinary skill in the art would understand the term install, installation, installing, etc. in the context of the present application to include both loading a program into memory implementing or configuring the databases to function. Furthermore, the ordinary definition of install is "to set in position and connect (i.e., load) or adjust for use (i.e., implement and configure). Moreover, the original specification specifically contemplates using the information provided by the expert and end user to install the software package using databases, pathways, and user information (see the original application disclosure at pages 6-7 and other text). Thus, the applicants amended the claims to clarify that the present invention relates to implementation installation and not simply load installation. To the extent the Examiner wishes the applicants to amend the claims to the broader install (which includes both load or implement), the applicants would be happy to do so, but believe the term implement better defines the present invention.

Regarding the rejection of claim 5 based on the use of the word derived for default, the applicants disagree with the Examiner's position but have amended the claim back to the original language to expedite the application.

Regarding the term independent module, the Examiner is respectfully directed to the example provided of Great Plains Solomon Select/Primer where it is explained that the software package comprises over 50 separate modules that can be separately installed depending on a companies needs. It is respectfully submitted that this example fully supports the phrase independent module and the Examiner is reminded that the terms in the claims do not need to have one-to-one antecedent basis in the written description.



Regarding the Examiner's position that the statement "ensure the later addition independent modules are implemented consistent with the software package" is new matter, the applicants respectfully disagree. In particular, the statement is an inherent or necessary quality of using the present invention and as such is not new matter or unsupported by the original disclosure.

Based on the foregoing it is respectfully submitted that the claims as presently submitted conform to all requirements of 35 U.S.C. § 112. Withdrawal of the rejection under 35 U.S.C. § 112 is respectfully requested.

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No claim related fees are believed to be due with this response. In the event any such fees are due, please debit Deposit Account 08-2623.

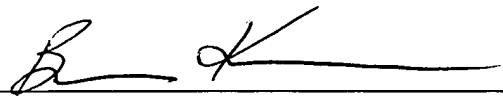
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The applicants respectfully request that the Examiner consider this Amendment and Response. The applicant submits that the pending claims are presently in condition for allowance and that no new matter has been introduced by this response. The applicant believes that the proposed response does not raise new issues or necessitate the undertaking of any additional search of art by the Examiner, because all of the elements were either earlier claimed or inherent in the claims as examined. Therefore, the amendment should allow for immediate action by the Examiner. Alternatively, the Applicants believe that entry of the response would place the application in better form for appeal, should the Examiner dispute the patentability of the claims.

The application now appearing to be in form for allowance, reconsideration and allowance thereof is respectfully requested.

Respectfully submitted this March 22, 2006

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